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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/010,317	01/21/1998	MAGNUS HOOK	TAMK:189	8522

7590 03/26/2003

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EXAMINER

ZEMAN, ROBERT A

ART UNIT PAPER NUMBER

1645

DATE MAILED: 03/26/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/010,317

Applicant(s)

HOOK ET AL.

Examiner

Robert A. Zeman

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 February 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 10 February 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): see attached.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☒ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.Claim(s) objected to: none.Claim(s) rejected: 54-59.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

ADVISORY ACTION

The amendment filed on 2-27-2003 is acknowledged and has been entered. Claim 54 has been amended. Claims 54-59 are pending.

An appeal under 37 CFR 1.191 was filed in this application on 2-10-2003. Appellant's brief is due on 4-10-2003 in accordance with 37 CFR 1.192(a).

Applicant is reminded that newly submitted claim 54 is still directed to an invention that is independent or distinct from the invention originally claimed. As outlined in the previous Office action, SEQ ID NO:12, 14-16, 21-53, 62-85, 88-102 and 105 recited in claim 54 remain withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. The examination of claim 54 remains limited to SEQ ID NO:2, 4, 6, 8, 10, 13, 17-20, 54-55, 57, 59-61, 86 and 103-104.

Priority

As outlined previously, the instant application is drawn to methods of generating an antibody that binds to a fibronectin-binding domain of a fibronectin-binding protein and inhibits the binding of said fibronectin-binding protein to fibronectin. Said method comprises administering to an animal or human a peptide of a fibronectin-binding protein that **does not** bind to fibronectin. Said peptides are recited as having the amino acid sequences of SEQ ID NO:2-4, 6, 8, 10, 13, 17-20, 54-55, 57, 59-61, 86 and 103-104. As stated previously, it is not apparent that all the claimed sequences are disclosed in the priority document 60/036,139. Applicant has provided a chart correlating the claimed SEQ ID NOs of the instant application with their support in application 60/036,1369. Unfortunately, said chart is insufficient with

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regard to SEQ ID NO:2 and 60-105. Said sequences need to be identified by page and line number when disclosed in a body of text (SEQ ID NO:60-62). Additionally, when said sequences are disclosed in a figure, it is suggested that a marked-up copy of said figure be used to identify said sequences. Consequently, with regard to SEQ ID NO:2 and 60-105, the filing date of the instant application will be used as the priority date.

Claim Rejections Withdrawn

The rejection of claim 54 under 35 U.S.C. 112, second paragraph, as being rendered vague and indefinite by the use of the term “consists essentially of” is withdrawn in light of the amendment thereto.

Claim Rejections Maintained

35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The rejection of claims 54-59 rejected under 35 U.S.C. 103(a) as being unpatentable over Sun et al. (Infection and Immunity, Vol. 65, No. 2, 1997, pages 537-543 – IDS-5) is maintained for reasons of record. Applicant's assertion that the amendment to claim 54 was sufficient to overcome said rejection is incorrect. It was stated in the interview that said amendment would be sufficient to overcome the rejection under 35 U.S.C. 112, second paragraph (see Paper No 30).

The rejection of claims 54-59 rejected under 35 U.S.C. 103(a) as being unpatentable over Hook et al. (WO 92/02555 – IDS-5) is maintained for reasons of record. Applicant's assertion that the amendment to claim 54 was sufficient to overcome said rejection is incorrect. It was stated in the interview that said amendment would be sufficient to overcome the rejection under 35 U.S.C. 112, second paragraph (see Paper No 30).

The rejection of claims 54-59 rejected under 35 U.S.C. 103(a) as being unpatentable over Hook et al. (US Patent 5,440,014 – IDS-5) is maintained for reasons of record. Applicant's assertion that the amendment to claim 54 was sufficient to overcome said rejection is incorrect. It was stated in the interview that said amendment would be sufficient to overcome the rejection under 35 U.S.C. 112, second paragraph (see Paper No 30).

The rejection of claims 54-59 rejected under 35 U.S.C. 103(a) as being unpatentable over Huff et al. (Journal of Biological Chemistry Vol. 269, No. 22, 1994, pages 15563-155705 – IDS-

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5) is maintained for reasons of record. Applicant's assertion that the amendment to claim 54 was sufficient to overcome said rejection is incorrect. It was stated in the interview that said amendment would be sufficient to overcome the rejection under 35 U.S.C. 112, second paragraph (see Paper No 30).

Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert A. Zeman whose telephone number is (703) 308-7991. The examiner can normally be reached on Monday- Thursday, 7am -5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith can be reached on (703) 308-3909. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.


LYNETTE R. F. SMITH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

Robert A. Zeman
March 25, 2003